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Atty. Docket Nbr. RSW9-2000-0002-US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Ronald P. Doyle

Serial Nbr: 09/537,068

Filed: March 28, 2000

For: Using Biometrics on Pervasive Devices for Mobile Identification

Art Unit: 2134

Examiner: Norman M. Wright

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF IN SUPPORT OF**  
**APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF APPEALS**

Sir:

Appellant herewith submits an appeal brief in support of the appeal to the Board of Appeals from the decision dated June 1, 2005 of the Primary Examiner finally rejecting all Claims 1 - 27.

The appeal brief fee of \$500.00 is:

  
  

Enclosed.

Not required. (Fee paid in prior appeal.)

Charged to Deposit Account No. 09/0461. A duplicate copy of this sheet is

enclosed.

Oral Hearing is:

  

Not requested.

Requested. See first paragraph of accompanying appeal brief.

Date: February 15, 2006

Respectfully submitted,

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Serial No. 09/537,068



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EXPRESS MAIL CERTIFICATE

“Express Mail” label number: ED762867157US Date of Deposit: February 15, 2006

**WE REQUEST THE DATE OF DEPOSIT AS THE DATE FILED.**

I hereby certify that the following enclosed or attached papers and fee

- (1) Transmittal of Patent Appeal Brief, requesting payment of Appeal Brief Fee from deposit account (1 page, in duplicate)
- (2) Appeal Brief (29 pages)
- (3) Business Reply Postcard

are being deposited with the United States Postal Service “Express Mail Post Office to Addressee” service under 37 C.F.R. §1.10 on the date indicated above and are addressed to Mail Stop Appeal Brief - Patent, Commissioner for Patents, Alexandria, VA 22313-1450.

Marcia L. Doubet  
(Name of person mailing paper or fee)

*Marcia L. Doubet*  
(Signature of person mailing paper or fee)



*Attorney Docket RSW9-2000-0002-US1*

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

In re application of Ronald P. Doyle

February 15, 2006

Serial Nbr: 09/537,068

Filed: March 28, 2000

For: Using Biometrics on Pervasive Devices for Mobile Identification

Art Unit: 2134

Examiner: Norman M. Wright

**APPELLANT'S BRIEF ON APPEAL**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is an Appeal seeking reversal of the decision of the Primary Examiner, finally rejecting all current claims of the subject patent application.

02/17/2006 MAHMEDI 00000019 090461 09537068  
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Serial No. 09/537,068

-1-

Docket RSW9-2000-0002-US1

**1) REAL PARTY IN INTEREST**

The real party in interest is the Assignee, International Business Machines Corporation (“IBM”).

**2) RELATED APPEALS AND INTERFERENCES**

Appellant, the Appellant’s legal representative, and the assignee, have no personal knowledge of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal.

**3) STATUS OF CLAIMS**

Claims 1 - 27 stand rejected. Claims 1 - 27 are under appeal.

**4) STATUS OF AMENDMENTS**

An Amendment After Final Rejection was filed on July 25, 2005, responsive to the Final Rejection mailed on June 1, 2005. This amendment has been reviewed by the Examiner, and has been denied entry.

**5) SUMMARY OF CLAIMED SUBJECT MATTER**

1. Appellant’s independent Claims 1, 10, and 19 specify a limitation of “capturing, using a biometric input reader which is attached to or incorporated within a mobile pervasive device possessed by a first party, biometric data of a second party” (Claim 1, lines 4 - 6, emphasis added) and another limitation of “identifying said second party using said captured biometric data by comparing said captured biometric data to previously-stored biometric data” (Claim 1, lines 7

- 8, emphasis added). In other words, when someone (the “first party”) possesses a mobile pervasive device, he or she can use this (mobile) device to determine the identity of (i.e., to identify) some other party (the “second party”). Specification, p. 1, lines 5 - 6; p. 12, lines 9 - 13. This is to be distinguished from using biometrics to control access to the device, which is known in the art. Specification, p. 12, lines 13 - 14.

2. Dependent Claims 3, 12, and 21 specify a limitation of “wherein said retrieved information comprises a photograph of a party to whom said biometric data corresponds” (Claim 3, lines 1 - 2, emphasis added). For example, the device possessor (“first party”) might have a package to be delivered to a person unknown to him or her; by having a photograph of the intended recipient transmitted to, and displayed upon, the mobile pervasive device, the device possessor can ensure that the “second party” is the person who is supposed to receive the package (and not an impostor). Specification, p. 13, lines 14 - 19; p. 14, lines 9 - 13.

3. Dependent Claims 8, 17, and 26 specify a limitation of “enabl[ing] on-demand creation of a secure meeting site by repeating ... [the] capturing and ... [the] identifying for each of a plurality of meeting attendees” (Claim 8, lines 2 - 4, emphasis added). For example, the device possessor (“first party”) might travel to an arbitrary and unsecured meeting location, and by capturing biometric information from people (a plurality of “second parties”) desiring to attend a meeting in that location, the first party can identify whether those people are the people who are trusted to participate in a security-sensitive meeting. Specification, p. 16, lines 1 - 16; p. 16, line 20 - p. 17, line 2.

4. Dependent Claims 9, 18, and 27 specify a limitation of “exchang[ing] a trusted message by ... [the] capturing and ... [the] identifying wherein said second party is a potential recipient of said trusted message” (Claim 9, lines 2 - 4, emphasis added). For example, the device possessor (“first party”) might use his or her device for delivering a confidential message to some other party unknown to him or her, and may therefore use techniques of the present invention to determine whether this “second party” whose biometric data was captured is, in fact, the intended message recipient. Specification, p. 13, lines 14 - 19.

5. Independent Claims 1 and 10, as well as dependent Claims 2, 6 - 9, 11, and 15 - 18 include means plus function terminology. Structure, material, or acts supporting this terminology are described in Appellant’s specification, as will now be described.

6. With regard to independent Claims 1 and 10, the text on p. 2, lines 1 - 9 describes mobile pervasive devices in general, and biometric input readers are generally described on p. 3, lines 6 - 13. A device that may be used by the “first party” (i.e., the device possessor) of these independent claims is described on p. 8, line 9 - p. 9, line 8. See also **Fig. 1**. Page 12, lines 9 - 13, as well as **Blocks 300 - 310 of Fig. 3** and corresponding text on p. 13, lines 3 - 5, discuss using the mobile pervasive device to “captur[e] ... biometric data of a second party” (“means for capturing ...”; Claim 1, lines 4 - 6). The “means for identifying ...” limitation is discussed on p. 12, lines 15 - 20, as well as **Blocks 320 - 370 of Fig. 3** and corresponding text on p. 13, line 6 - p. 14, line 13.

7. With regard to dependent Claims 2 and 11, the “means for transmitting ...” limitation is described on p. 9, lines 3 - 6 (and generally continuing through p. 11, line 3); p. 11, lines 15 - 20; p. 12, lines 3 - 6 and lines 15 - 16; and is illustrated in **Fig. 3** at reference numbers **320 - 325**, with corresponding text found on p. 13, lines 6 - 8. See also **Fig. 2**, as well as reference number **32** of **Fig. 1**. The “means for retrieving ...” limitation is described on p. 10, lines 7 - 8, as well as at reference numbers **330 - 340** of **Fig. 3** and corresponding text on p. 13, lines 9 - 10. See also reference number **48** of **Fig. 2**. The “means for returning ...” limitation is described on p. 9, line 3 - p. 11, line 3; p. 11, lines 15 - 20; p. 12, lines 3 - 6; and is illustrated at reference numbers **350 - 355** of **Fig. 3**, with corresponding text found on p. 14, lines 8 - 9.

8. With regard to dependent Claims 6 and 15, the “means for filtering ...” limitation is described on p. 13, line 19 - p. 14, line 5 and p. 14, line 17 - p. 15, line 3.

9. With regard to dependent Claims 7 and 16, these claims further describe the “means for identifying ...” limitation from independent Claims 1 and 9, according to the text on p. 16, line 17 - p. 17, line 3.

10. With regard to dependent Claims 8 and 17, these claims further describe repeating of the “means for capturing ...” and “means for identifying ...” limitations of independent Claims 1 and 9, with this iterative processing described on p. 16, lines 11 - 14 and p. 17, lines 1 - 2.

11. With regard to dependent Claims 9 and 18, these claims further describe the “means for

capturing ..." and "means for identifying ..." limitations of independent Claims 1 and 9, according to the text on p. 13, lines 14 - 18.

## **6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

12. The first ground of rejection presented for review is whether Claims 1 - 4, 7, 10 - 13, and 16 are anticipated under 35 U.S.C. §102(e) by U. S. Patent 6,510,236 to Crane et al. (hereinafter, "Crane").

13. The second ground of rejection presented for review is whether Claims 5 - 6, 8 - 9, 14 - 15, and 17 - 27 are unpatentable under 35 U.S.C. §103(a) over Crane in view of U. S. Patent 6,016,476 to Maes et al. (hereinafter, "Maes").

## **7) ARGUMENT**

### **7.1) First Ground of Rejection**

14. Paragraph 2 of the Office Action dated June 1, 2005 (hereinafter, "the Office Action") states that Claims 1 - 4, 7, 10 - 13, and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent 6,510,236 to Crane. Of these claims, the independent claims are 1 and 10.

15. Appellant respectfully submits that a *prima facie* case of anticipation under 35 U.S.C. §102 has not been made out as to his Claims 1 - 4, 7, 10 - 13, and 16. Section 706.02 of the MPEP, "Rejection on Prior Art", states in Section IV, "Distinction Between 35 U.S.C. 102 and

103", the requirements for establishing a *prima facie* case of anticipation under this statute, noting that "... for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly" (emphasis added). This requirement is also stated in MPEP §2131, "Anticipation -- Application of 35 U.S.C. 102(a), (b), and (e)", which states (in its final paragraph) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference", quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added. This final paragraph of MPEP §2131 also states "The elements must be arranged as required by the claim ...", quoting *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), emphasis added.

16. The burden for rebutting a rejection under 35 U.S.C. 102 does not pass to Appellant until a *prima facie* case of anticipation has been made out. See *In re Bass*, 177 USPQ 178, 186 (C.C.P.A. 1973), which held:

From the evidence available to it, the initial burden of making out a *prima facie* case of prior invention is on the Patent Office. . . . When the Patent Office has made out a *prima facie* case of priority the burden would then shift to the applicant to rebut it.

Accordingly, Appellant respectfully submits that the burden has not passed. For the sake of expediency, Appellant will, however, provide a rebuttal herein of the analysis provided in the Office Action.

#### **7.1.1) Rejection of Independent Claims 1 and 10**

17. Appellant respectfully submits that the Office Action fails to identify where Crane

teaches “each and every element” of his independent Claims 1 and 10, and fails to demonstrate that Crane teaches “elements … arranged as required by [Appellant’s] claim”, and thus the Office Action analysis fails to make out a *prima facie* case of anticipation, in violation of the above-quoted MPEP §706.02 and §2131, as will now be demonstrated.

18. Paragraph 2 of the Office Action analyzes Appellant’s Claims 1 - 4, 7, 10 - 13, and 16 together, and cites Crane’s Abstract; **Figs. 1 - 4**; col. 1, lines 45 *et seq.*; col. 2, lines 20 *et seq.*; col. 3, lines 8 - 13, 29 - 32, and 47 - 67; col. 4, lines 25 *et seq.*; col. 5, lines 1 - 40, claim 23; and col. 6, lines 25 *et seq.* as teaching the limitations of these claims.

19. Appellant’s independent Claims 1 and 10 (as well as Claim 19) specify “a mobile pervasive device possessed by a first party” (Claim 1, line 5, emphasis added) and “using a biometric input reader which is attached to or incorporated within [this device to capture] biometric data of a second party” (Claim 1, lines 4 - 6, emphasis added). These claims further specify “identifying said second party …” (Claim 1, lines 7 - 8, emphasis added). Accordingly, it is clear that there are two distinct parties (*i.e.*, the “first party” and the “second party”) involved when using Appellant’s claimed invention. Furthermore, it is clear that these distinct “first” and “second” parties are simultaneously involved when capturing biometric data and using this biometric data for identification. See Appellant’s claim language in Claim 1, line 5, specifying that the first party possesses the device, and in Claim 1, line 7, specifying that the second party is being identified.

20. Appellant's invention as claimed in Claims 1 and 10 (and also Claim 19) enables, for example, the first party to identify the second party for determining whether this second party is the intended recipient of a confidential message or a package, even though the first party might not personally know this second party. Specification, p. 13, lines 14 - 19.

21. Appellant finds no teaching in Crane that pertains to two distinct parties who are simultaneously participating in any action. The citations from the Office Action (see paragraph 18, above) will now be discussed in more detail.

22. Crane's Abstract describes authentication of a device user. There is no mention of any "second party" distinct from a "first party" who possesses this device. Nor is such teaching found in Crane's **Figs. 1 - 4** or in col. 1, lines 45 *et seq.* In col. 2, lines 20 *et seq.*, Crane states that a "request for authentication" is passed to an application server, and that this request "includes a user id and device id identifying a respective client and an authentication device coupled thereto" (col. 2, lines 29 - 32, emphasis added). Appellant finds no teaching of two distinct parties (*i.e.*, a "first party" and a "second party", as in Appellant's claim language) in this text. Such teaching is also not found in the cited text in col. 3, lines 8 - 13 (discussing authentication device types); col. 3, lines 29 - 32 (noting that "authentication devices" may include biometric scanners); or col. 3, lines 47 - 67 (discussing processing of "authentication data ... including a user id"; col. 3, lines 51 - 52 and lines 64 - 65). The cited text from col. 4, lines 25 *et seq.* describe authentication and "validating the user" (col. 4, lines 40 - 42 and line 44, emphasis added). In the cited text from col. 5, lines 1 - 40, Crane states "the application server

processes the response ... and, as a result, knows the user is to be given access" (col. 5, lines 33 - 35, emphasis added). This authenticating of a user is distinct from Appellant's two-party claim limitations; see Appellant's specification, p. 12, lines 13 - 14, stating that Appellant's invention "is to be distinguished from use of biometrics to allow access to the pervasive device itself". Appellant finds no teaching in Crane's Claim 23 (which pertains to determining whether an authentication device can be identified) of a technique involving a "first party" and a "second party". Crane's col. 6, lines 25 *et seq.* states (*inter alia*) that a "client" should be "broadly construed to mean one who requests or gets the file" (col. 6, lines 48 - 49). However, Appellant respectfully submits that this does not suggest his claimed two-party limitations (i.e., limitations pertaining to a first party and to a second party).

23. In summary, the Office Action fails to cite a reference that teaches each and every element of Appellant's independent Claims 1 and 10 (or Claim 19, which has analogous limitations), as currently presented, arranged as required by Appellant's claim language.

24. In an unentered amendment dated July 25, 2005 (which is hereby incorporated herein by reference, and which is hereinafter referred to as "the unentered amendment"), Appellant amended his independent Claims 1 and 10 (as well as independent Claim 19) to specify that the "mobile pervasive device [is] possessed by a user" (Claim 1, line 5 of the unentered amendment) and that the captured biometric data is that of "another being encountered by said possessor" (Claim 1, lines 4 - 6 of the unentered amendment, emphasis added), and to specify that the "identifying" limitation identifies "said encountered being" (Claim 1, line 7 of the unentered

amendment). See Appellant's specification, p. 12, lines 11 - 13 ("recording ... the biometric data of another being encountered by the possessor of the pervasive device"; emphasis added).

Appellant explained in the unentered amendment that if a pervasive device is possessed by a user "A", for example, Crane's teachings are directed toward authentication of user A, whereas Appellant's claims are directed toward authenticating another being such as a user "B", who is encountered by user A (while user A is the possessor of the pervasive device).

25. With regard to the limitations of Claims 1, 10, and 19 as specified in this unentered amendment, Appellant respectfully submits that Crane has no teaching of a device possessor "encounter[ing] another being", or identifying such "encountered being".

26. The Examiner stated in an Interview Summary attached to an Advisory Action dated September 14, 2005 (which Advisory Action responds to the unentered amendment, and which is referred to hereinafter as "the Advisory Action") that "The examiner's position is that whenever a person/entity picks up or uses the biometric [sic] device they infact becomes [sic] a user.". However, Appellant respectfully submits that there is no teaching in Crane of any other person/entity "pick[ing] up or us[ing]" the biometric device discussed therein, nor is there any teaching of encountering such other person/entity, in contrast to the claim limitations specified in the independent claims of the unentered amendment.

27. Furthermore, with regard to Appellant's claim language from the unentered amendment, the analysis presented in the Interview Summary cannot be aligned to Appellant's claim language

because there are simply not enough (distinct) parties. That is, if this “other” person/entity somehow *becomes* “a user [who, then, possesses the mobile pervasive device]” (Claim 1, line 5 of the unentered amendment, emphasis added), then there is no “another being” that can be aligned to the “encountered by said possessor” or the “identifying said [another] encountered being” claim limitations specified on lines 6 and 7 of Claim 1. That is, the person who is the “user”, in this claim language, is the person who possesses the mobile pervasive device and who also encounters some “another being”.

28. Accordingly, Appellant also respectfully submits that the independent claims of the unentered amendment, if entered, would be patentable over Crane.

29. Because the Office Action fails to cite a reference that teaches each and every element of Appellant’s independent Claims 1 and 10, arranged as required by Appellant’s claim language, the §102 rejection fails to meet the requirements of Sections 706.02 and 2131 of the MPEP (which were noted above in paragraph 15). The Office Action therefore fails to make out a *prima facie* case of anticipation as to these independent claims. Without more, these claims are deemed patentable. See *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.

30. Independent Claims 1 and 10 are therefore deemed patentable over Crane.

### 7.1.2) Rejection of Dependent Claims 3 and 12

31. The Office Action provides no separate discussion of dependent Claims 3 and 12; rather, they are discussed in combination with independent Claims 1 and 10. As discussed above in paragraph 22, the text cited in paragraph 2 of the Office Action fails to teach all limitations of these independent claims. Therefore, having failed to make out a *prima facie* case of anticipation with regard to independent Claims 1 and 10, a *prima facie* case of anticipation also has not been made out with regard to dependent Claims 3 and 12.

32. Furthermore, Claims 3 and 12 (as well as dependent Claim 21) specify a limitation of “said retrieved information comprises a photograph of a party to whom said biometric data corresponds” (Claim 3, lines 1 - 2, emphasis added). Paragraph 2 of the Office Action uses the phrase “a photograph {biometrics, picture/scan of finger, palm, eye etc}”. However, Appellant’s claim language does not specify “a photograph/scan of a finger”, or a photograph of biometric data of any type: the claim language specifies “a photograph of a party to whom [the fingerprint, as one example of biometric data] corresponds” (Claim 3, line 2, emphasis added).

33. In addition, Appellant’s claim language specifies that the photograph is the information “retrieved, by said remote server, ... using said transmitted biometric data” (referring to the antecedent in Claim 2, lines 4 - 5, emphasis added). In other words, the biometric data of the “second party” is used, by the remote server, to retrieve “a photograph” of that second party. See also Appellant’s Specification, p. 13, lines 10 - 12 and lines 16 - 17; p. 14, lines 9 - 12; and Block 360 of Fig. 3, which describe this scenario of displaying the information that was retrieved

using the biometric data, where this retrieved information may be a photo or “picture of the person corresponding to the captured biometric data” (p. 14, lines 11 - 12). Appellant finds no teaching in Crane of “retrieved information [that] comprises a photograph of a party” (Claim 3, lines 1 - 2, emphasis added), nor “retrieving, by said remote server, information [comprising a photograph] ... using said transmitted biometric data” (again referring to the antecedent in Claim 2, lines 4 - 5), as is required by Appellant’s claim language.

34. With regard to the Examiner’s contention in the Advisory Action that the second party “becomes the user”, Appellant respectfully points out that this second party would have no need to see his own photograph. Clearly, the photograph of the second party is for use by the (distinct) first party (who is the device possessor, in Appellant’s claim language).

35. Thus, because the Office Action fails to cite a reference that teaches each and every element of Appellant’s dependent Claims 3 and 12, arranged as required by Appellant’s claim language, the §102 rejection fails to meet the requirements of Sections 706.02 and 2131 of the MPEP (which were noted above in paragraph 15). The Office Action therefore fails to make out a *prima facie* case of anticipation as to these dependent claims. According to the above-described holding in *In re Oetiker*, without more, dependent Claims 3 and 12 (as well as Claim 21, which has analogous limitations) are deemed patentable. Claims 3 and 12 (and 21) are also deemed patentable by virtue of the allowability of the independent claims from which they depend.

### **7.1.3) Rejection of Dependent Claims 2, 4, 7, 11, 13, and 16**

36. Dependent Claims 2, 4, 7, 11, 13, and 16 stand or fall with independent Claims 1 and 10 from which they depend. Thus, these claims are deemed allowable by virtue of the allowability of these independent claims.

### **7.2) Second Ground of Rejection**

37. Paragraph 4 of the Office Action states that Claims 5 - 6, 8 - 9, 14 - 15, and 17 - 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Crane in view of U. S. Patent 6,016,476 to Maes et al. Claim 19 is an independent claim. The remaining ones of these claims are dependent claims.

38. Appellant respectfully submits that a *prima facie* case of obviousness under 35 U.S.C. §103 has not been made out as to his Claims 5 - 6, 8 - 9, 14 - 15, and 17 - 27. Section 706.02(j) of the MPEP, “Contents of a 35 U.S.C. 103 Rejection”, states the requirements for establishing a *prima facie* case of obviousness under this statute, noting that three criteria must be met. These criteria are (1) a suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; (2) a reasonable expectation of success; and (3) the combination must teach or suggest all the claim limitations. This text goes on to state that “The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.”. The three requirements for establishing a *prima facie* case of obviousness are also stated in MPEP §2142, “Legal Concept of *Prima Facie* Obviousness”, and MPEP §2143, “Basic Requirements of a *Prima Facie* Case of Obviousness”.

### **7.2.1) Rejection of Independent Claim 19**

39. Regarding the §103 rejection of independent Claim 19, Appellant respectfully submits that this claim is patentable over the references for the same reasons discussed above in **Section 7.2.1** with regard to independent Claims 1 and 10, which specify limitations analogous to those of independent Claim 19. In particular, Appellant finds no teaching in Crane of two distinct parties that can be aligned to his claimed “first party” and “second party”, as has been demonstrated in **Section 7.2.1**, and no text from Maes has been cited as teaching these distinct parties. (See paragraph 7 of the Office Action, which states that Claim 19 is “rejected under the same rationale” that has been presented, but fails to provide any additional citations to Maes.)

40. Accordingly, Appellant respectfully submits that the Office Action fails to make out a *prima facie* case of unpatentability as to independent Claim 19, and without more, this claim is deemed patentable.

### **7.2.2) Rejection of Dependent Claims 8, 17, and 26**

41. Appellant respectfully submits that the references (whether taken singly or in combination) fail to teach or suggest all the claim limitations of these claims. The requirements described in paragraph 38, above, for establishing a *prima facie* case of obviousness have therefore not been met, as will now be described in more detail.

42. Dependent Claims 8, 17, and 26 specify “on-demand creation of a secure meeting site” by repetitively “capturing ... biometric data of” a plurality of meeting attendees and “identifying

[each of said meeting attendees] using said captured biometric data" (Claim 8, lines 2 - 4, referring also to antecedents in Claim 1, lines 4 - 8).

43. Paragraph 6 of the Office Action admits that Crane does not "explicitly" teach "a secure meeting where the coded means is used to identify attendees at a meeting" (which Appellant notes is not the specific language of his Claims 8, 17, and 26). Col. 2, lines 50 - 58 of Maes are then cited as teaching the limitations of these claims.

44. Appellant respectfully submits that the cited text from Maes does not pertain to "a plurality of meeting attendees", or a plurality of any other type of people, nor does this text teach a two-party (*i.e.*, "first party" and "second party") approach as has been explicitly claimed by Appellant in the claims from which dependent Claims 8, 17, and 26 depend.

45. Accordingly, Appellant respectfully submits that the combination of references does not "teach or suggest all the claim limitations", in violation of the above-described requirements for a 35 U.S.C. 103 Rejection (as specified in paragraph 38). Without more, these dependent claims are deemed patentable. Furthermore, these dependent claims are deemed patentable by virtue of the allowability of the independent claims from which they depend.

### **7.2.3) Rejection of Dependent Claims 9, 18, and 27**

46. Appellant respectfully submits that the references (whether taken singly or in combination) fail to teach or suggest all the claim limitations of these claims. The requirements

described in paragraph 38, above, for establishing a *prima facie* case of obviousness have therefore not been met, as will now be described in more detail.

47. Dependent Claims 9, 18, and 27 specify “exchang[ing] a trusted message” by performing the capturing of biometric data and the identifying of the second party using that biometric data, “wherein said second party is a potential recipient of said trusted message” (Claim 9, lines 2 - 4). In other words, the first party might use his possessed device as a means of securely delivering a trusted (or confidential) message to some other (second) party who is currently unknown to the first party. See, for example, p. 13, lines 14 - 17 of Appellant’s specification, where this scenario is discussed.

48. Paragraph 6 of the Office Action admits that Crane does not “explicitly” teach “the transmission of a trusted message”. Col. 2, lines 23 - 67 *et seq.*; col. 3, lines 15 - 35 *et seq.*; and col. 3, lines 40 - 67 *et seq.* of Maes are then cited as teaching the limitations of these claims.

49. Appellant respectfully submits that the cited text from Maes does not pertain to “biometric data of a second party” (see antecedent in Claim 1, lines 5 - 6), or a “second party [who] is a potential recipient of [a] trusted message” (Claim 9, lines 3 - 4). Rather, the cited text discusses “utiliz[ing] biometric security to provide user verification” (col. 2, lines 32 - 33) and providing “biometric verification of a user” (col. 3, lines 21 - 22; see also col. 3, lines 46 - 47). Appellant respectfully submits that this text does not teach a two-party approach as has been claimed by Appellant in the claims from which dependent Claims 9, 18, and 27 depend. That is,

there is no discussion of any “other” user, whereas Appellant’s claim language clearly requires a “first party” and a “second party” (and these parties are clearly distinct, as has been discussed; see, for example, paragraph 19, above).

50. Accordingly, Appellant respectfully submits that the combination of references does not “teach or suggest all the claim limitations”, in violation of the above-described requirements for a 35 U.S.C. 103 Rejection (as specified in paragraph 35). Without more, dependent Claims 9, 18, and 27 are deemed patentable. These dependent claims are also deemed patentable by virtue of the allowability of the independent claims from which they depend.

#### **7.2.4) Rejection of Dependent Claim 21**

51. Regarding the §103 rejection of dependent Claim 21, Appellant respectfully submits that this claim is patentable over the references for the same reasons discussed above in **Section 7.1.2** with regard to dependent Claims 3 and 12, which specify limitations analogous to those of dependent Claim 3. In particular, Appellant finds no teaching in the cited references of the “photograph of a party” limitation, as has been demonstrated in **Section 7.1.2**.

52. Accordingly, Appellant respectfully submits that the Office Action fails to make out a *prima facie* case of unpatentability as to dependent Claim 21, and without more, this claim is deemed patentable. Claims 21 is also deemed patentable by virtue of the allowability of independent Claim 19 from which it depends.

**7.2.5) Rejection of Dependent Claims 5 - 6, 14 - 15, 20, and 22 - 25**

53. Dependent Claims 5 - 6, 14 - 15, 20, and 22 - 25 stand or fall with the independent claims from which they depend. Thus, these claims are deemed allowable in view of the allowability of independent Claims 1, 10, and 19.

**8) CONCLUSION**

For the reasons set out above, Appellant respectfully contends that each appealed claim is patentable, and respectfully requests that Examiner's Final Rejection of appealed Claims 1 - 27 should be reversed.

Respectfully submitted,



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## CLAIMS APPENDIX

### CLAIMS AS CURRENTLY PRESENTED:

1       Claim 1: A computer program product for using biometrics on pervasive devices for mobile  
2       identification, said computer program product embodied on a medium readable by said pervasive  
3       device and comprising:

4               programmable code means for capturing, using a biometric input reader which is attached  
5       to or incorporated within a mobile pervasive device possessed by a first party, biometric data of a  
6       second party; and

7               programmable code means for identifying said second party using said captured biometric  
8       data by comparing said captured biometric data to previously-stored biometric data.

1       Claim 2: The computer program product according to Claim 1, further comprising:

2               programmable code means for transmitting said captured biometric data from said mobile  
3       pervasive device to a remote server;

4               programmable code means for retrieving, by said remote server, information from a  
5       repository using said transmitted biometric data; and

6               programmable code means for returning said retrieved information to said mobile  
7       pervasive device.

1       Claim 3: The computer program product according to Claim 2, wherein said retrieved  
2       information comprises a photograph of a party to whom said biometric data corresponds.

1       Claim 4: The computer program product according to Claim 2, wherein said retrieved  
2       information comprises access rights of a party to whom said biometric data corresponds.

1       Claim 5: The computer program product according to Claim 2, wherein said retrieved  
2       information comprises protected information not locally accessible to said mobile pervasive  
3       device.

1       Claim 6: The computer program product according to Claim 2 or Claim 5, further comprising:  
2               programmable code means for filtering, by said remote server, said retrieved information  
3       based upon a determined identity of said second party; and  
4               wherein said returned retrieved information is said filtered retrieved information.

1       Claim 7: The computer program product according to Claim 1, wherein said mobile pervasive  
2       device further comprises a locally-stored repository containing said previously-stored biometric  
3       data, and wherein said programmable code means for identifying compares, by said mobile  
4       pervasive device, said captured biometric data to said previously-stored biometric data in said  
5       locally-stored repository.

1       Claim 8: The computer program product according to Claim 1, wherein said computer program  
2       product is used to enable on-demand creation of a secure meeting site by repeating operation of  
3       said programmable code means for capturing and said programmable code means for identifying  
4       for each of a plurality of meeting attendees.

1       Claim 9: The computer program product according to Claim 1, wherein said computer program  
2       product is used to exchange a trusted message by performing operation of said programmable  
3       code means for capturing and said programmable code means for identifying wherein said second  
4       party is a potential recipient of said trusted message.

1       Claim 10: A system for using biometrics on pervasive devices for mobile identification, said  
2       system comprising:

3               a mobile pervasive device possessed by a first party;  
4               a biometric input reader attached to or incorporated within said mobile pervasive device;  
5               means for capturing biometric data of a second party using said biometric input reader;

6       and

7               means for identifying said second party using said captured biometric data by comparing  
8       said captured biometric data to previously-stored biometric data.

1       Claim 11: The system according to Claim 10, further comprising:

2               means for transmitting said captured biometric data from said mobile pervasive device to  
3       a remote server;  
4               means for retrieving, by said remote server, information from a repository using said  
5       transmitted biometric data; and  
6               means for returning said retrieved information to said mobile pervasive device.

1       Claim 12: The system according to Claim 11, wherein said retrieved information comprises a  
2       photograph of a party to whom said biometric data corresponds.

1       Claim 13: The system according to Claim 11, wherein said retrieved information comprises  
2       access rights of a party to whom said biometric data corresponds.

1       Claim 14: The system according to Claim 11, wherein said retrieved information comprises  
2       protected information not locally accessible to said mobile pervasive device.

1       Claim 15: The system according to Claim 11 or Claim 14, further comprising:  
2               means for filtering, by said remote server, said retrieved information based upon a  
3               determined identity of said second party; and  
4               wherein said returned retrieved information is said filtered retrieved information.

1       Claim 16: The system according to Claim 10, wherein said mobile pervasive device further  
2       comprises a locally-stored repository containing said previously-stored biometric data, and  
3       wherein said means for identifying compares, by said mobile pervasive device, said captured  
4       biometric data to said previously-stored biometric data in said locally-stored repository.

1       Claim 17: The system according to Claim 10, wherein said system is used to enable on-demand  
2       creation of a secure meeting site by repeating operation of said means for capturing and said  
3       means for identifying for each of a plurality of meeting attendees.

1       Claim 18: The system according to Claim 10, wherein said system is used to exchange a trusted  
2       message by performing operation of said means for capturing and said means for identifying  
3       wherein said second party is a potential recipient of said trusted message.

1       Claim 19: A method for using biometrics on pervasive devices for mobile identification, said  
2       method comprising the steps of:

3               capturing, using a biometric input reader attached to or incorporated within a mobile  
4       pervasive device possessed by a first party, biometric data of a second party; and  
5               identifying said second party using said captured biometric data by comparing said  
6       captured biometric data to previously-stored biometric data.

1       Claim 20: The method according to Claim 19, further comprising the steps of:  
2               transmitting said captured biometric data from said mobile pervasive device to a remote  
3       server;  
4               retrieving, by said remote server, information from a repository using said transmitted  
5       biometric data; and  
6               returning said retrieved information to said mobile pervasive device.

1       Claim 21: The method according to Claim 20, wherein said retrieved information comprises a  
2       photograph of a party to whom said biometric data corresponds.

1       Claim 22: The method according to Claim 20, wherein said retrieved information comprises  
2       access rights of a party to whom said biometric data corresponds.

1       Claim 23: The method according to Claim 20, wherein said retrieved information comprises  
2       protected information not locally accessible to said mobile pervasive device.

1       Claim 24: The method according to Claim 20 or Claim 23, further comprising the step of:  
2               filtering, by said remote server, said retrieved information based upon a determined  
3       identity of said second party; and  
4               wherein said returned retrieved information is said filtered retrieved information.

1       Claim 25: The method according to Claim 19, wherein said mobile pervasive device further  
2       comprises a locally-stored repository containing said previously-stored biometric data, and  
3       wherein said identifying step compares, by said mobile pervasive device, said captured biometric  
4       data to said previously-stored biometric data in said locally-stored repository.

1       Claim 26: The method according to Claim 19, wherein said method is used to enable on-demand  
2       creation of a secure meeting site by repeating operation of said capturing step and said  
3       identifying step for each of a plurality of meeting attendees.

1       Claim 27: The method according to Claim 19, wherein said method is used to exchange a trusted  
2       message by performing operation of said capturing step and said identifying step wherein said

3 second party is a potential recipient of said trusted message.

## **EVIDENCE APPENDIX**

**Appellant, the Appellant's legal representative, and the assignee have no personal knowledge of evidence requiring separate identification herein as bearing on this Appeal.**

## **RELATED PROCEEDINGS APPENDIX**

No related proceedings are personally known to Appellant, the Appellant's legal representative, or the assignee.